• U.S.S.N. 10/517,626 Examiner: J. M. Nolan Attorney Docket No.: SNI-003US Group Art Unit: 1626

REMARKS

Claims 1-46 and 49-60 were pending. Claim 17 has been cancelled. Claims 1, 5, 7, 8, 10, 13, 14-16, 51, 55, 59, and 60 have been amended. Claims 61-93 have been added. Therefore, claims 1-16, 18-46, and 49-93 will be pending upon entry of the present amendment.

Claims 1, 5, 7, 8, 10, 13, 14-16, 51, 59, and 60 have been amended to clarify the invention. Support for these amendments can be found in the claims as originally filed and the specification, as originally filed, for example, at least at page 14, lines 5 and 6. Support for the amendment to claim 55 can be found in the claim as originally filed and in the specification, for example, at least at page 10, lines 23 and 24. Support for new claims 61-93 can be found, for example, at least in the specification and claims as originally filed.

Rejection of Claims 1-46 and 49-60 under 35 U.S.C. § 102 (e)

Claims 1-46 and 49-60 are rejected under 35 U.S.C. § 102 (e) as being anticipated by Elworthy *et al.* (U.S. Patent No. 6,900,336). According to the Examiner, Elworthy *et al.* describes a compound of the formula:

Applicants' claims 1-46 and 49-53 are directed to compounds of Formula (I)-(V), pharmaceutical compositions comprising these compounds, and methods of using these compounds. Applicants respectfully submit that, as amended, claims 1-46 and 49-53 do not claim the compound cited above.

Furthermore, Applicants note that claim 54 and its dependent claims are directed to a method of treating a fertility condition in a female, by the administering to the female a prostaglandin EP4 receptor agonist. Elworthy *et al.* fails to teach or suggest the treatment of fertility disorders and fails to anticipate claims 54-60.

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Therefore, Applicants respectfully request that this rejection of claims 1-46 and 49-60 under 35 U.S.C. § 102 (e) be reconsidered and withdrawn.

Rejection of Claim 51 under 35 U.S.C. § 112, first paragraph

Claim 51 was rejected under 35 U.S.C. § 112, first paragraph, because "the specification, while being enabling for pharmaceutically acceptable salts of compounds according to the invention, does not reasonably provide enablement for prodrugs of the invention." Applicants disagree. However, in the interest of expediting prosecution of the application, Applicants have amend claim 51 such that prodrugs of the compounds are no longer recited. Therefore, Applicants respectfully request that this rejection of claim 51 under 35 U.S.C. § 112, first paragraph, be withdrawn.

Claim Objection

Claim 55 was objected to by the Examiner because the Examiner alleges that the drawing of formula (VI) contains a double bond (at variable B) and the bond is referred to as a dotted line in the text of the claim. Applicants respectfully submit that the bond in question is supposed to have been a dotted line and merely appeared as a double bond through a printing error. This bond is referred to throughout the claims and in the specification as being "undefined" and as a single bond. Therefore, Applicants have enlarged formula (VI) such that the dotted line in question is dotted and the objection is moot. Applicants respectfully request that this objection to claim 55 be withdrawn.

SUMMARY

Amendments to and/or cancellation of the claims should in no way be construed as an acquiescence to any of the Examiner's objections and/or rejections. The amendments to and/or cancellation of the claims are being made solely to expedite prosecution of the above-identified application. Applicants reserve the option to further prosecute the same or similar claims in the present or another patent application. The amendments made to the claims are not related to any issues of patentability.

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In view of the foregoing, entry of the amendments and remarks presented herein, favorable reconsideration and withdrawal of the rejections, and allowance of this application with all pending claims are respectfully requested. If a telephone conversation with Applicants' Attorney would expedite prosecution of the aboveidentified application, the Examiner is invited to call the undersigned at (617) 227-7400.

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